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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,339	11/17/2003	Woojin Lee	4819 US 01	2403
41696 7590 06/18/2009 VISTA IP LAW GROUP LLP 12930 Saratoga Avenue Suite D-2 Saratoga, CA 95070			EXAMINER PHILOGENE, PEDRO	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 06/18/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,339

Applicant(s)

LEE ET AL.

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) 45-72 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 is/are allowed.
- 6) ☒ Claim(s) 12-18, 20-29, 32-34, 36-40 and 42-44 is/are rejected.
- 7) ☒ Claim(s) 19, 30, 31, 35, 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 24, 28, 37-40, 42 rejected under 35 U.S.C. 102(b) as being anticipated by Meade (5,499,998).

Meade discloses a method of grasping an item comprising positioning the item between a first jaw (70) and a second jaw (72) of the tool; moving the first and second jaws to a contact position to grasp the item, as set forth in column 2, line 32-39; increasing the force applied to the item grasped between the jaws, the force applied to the grasped item as the jaws close to a locked position and allowing a closing force to be applied to the grasped item corresponding to the size of the item being grasped; as set forth in column 3, lines 5-21, lines 55-61, column 6, lines 40-64, column 8, lines 29-65, column 9, lines 1-8. The driving means and the grasping means being provided with an accommodating means (80) that allows continued movement of the Driving means towards a locked position even after the grasping means (70,72) contact a larger item so that the driving means can move to the locked position when the grasping means grasps items of different sizes, as set forth in column 3, lines 5-21, lines 55-61, column 6, lines 40-64, column 8, lines 29-65, column 9, lines 1-8. Furthermore, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 22, 25, 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Meade (5,499,998) in view of Kieturakis (5,752,973).

It is noted that Meade did not teach of a first drive cable and a second drive cable coupled to the first and second jaws; as claimed by applicant. However, in similar art, Kieturakis provides the evidences of the use of a first drive cable (50) and a second drive cable (50) coupled to the first and second jaws to actuate the jaws between open and closed positions.

Therefore, given the teaching of Kieturakis, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Meade, as taught by Kieturakis to actuate the jaws between open and closed positions.

Claims 23,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meade (5,499,998) in view of Kieturakis (5,752,923) in view of Morley et al. (6,840,938).

It is noted that the above combination of references discloses all the limitations, except for an electronic controller coupled with a user interface operated by a user; as claimed by applicant. However, in similar art, Morley et al provide the evidences of the use of an electronic controller coupled with a user interface, as set forth in column 2, lines 33-34; to move the jaws between an open position to a closed position.

Therefore, given the teaching of Morley et al it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Meade to include an electronic controller coupled to a user interface to move the jaws between an open position to a closed position.

Claims 29, 32-34, 36, 43, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meade (5,499,998) in view of Morley et al. (6,840,938).

It is noted that the above combination of references discloses all the limitations, except for an electronic controller coupled with a user interface operated by a user; as claimed by applicant. However, in similar art, Morley et al provide the evidences of the use of an electronic controller coupled with a user interface, as set forth in column 2, lines 33-34; to move the jaws between an open position to a closed position.

Therefore, given the teaching of Morley et al it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Meade to include an electronic controller coupled to a user interface to move the jaws between an open position to a closed position.

Allowable Subject Matter

Claims 1-11 are allowed.

Claims 19, 30, 31, 35, 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments, see Remarks, filed 11/26/08, with respect to the rejection(s) of claim(s) 1-44 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Meade/Kieturakis.

Furthermore, an intended use clause found in the preamble of an apparatus claim is not afforded the effect of a distinguishing limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breadth from the preamble. See in re Casey, 152 USPQ 235 (CCPA 1967); Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
June 16, 2009